

**REMARKS**

In the instant application, claims 1-21 are under consideration. Claims 22-29 are withdrawn from consideration as being directed to non-elected inventions. Claims 1-12 have all been amended to change the recitation of "Therapeutic protein:X" to "Therapeutic protein X" in order to conform with the terminology used in the specification. See, for example, Table 1, pages 11-251, left column (reciting "Therapeutic protein X"). Claims 1 and 5-6 have also been amended to define "Therapeutic protein X" as at least one of the proteins listed in Table 1 of the specification (pages 11-251). Thus, the amended claims are fully supported by the specification. Each of the issues raised in the Office Action of August 20, 2003, are addressed herein below.

**Oath/Declaration**

The Office objects to the oath/declaration because there is a stray mark where Dr. Haseltine has signed. The declaration filed in the instant application does contain a stray mark but that mark is in the address line, where the address is correct. It appears that Dr. Haseltine mistakenly began signing his name in the address line. But because there has been no amendment to the application, Applicants do not believe that a new declaration is required. The Office cites to MPEP § 608.01(b) as authority requiring a new oath or declaration but that section pertains to the Abstract, not to an oath or declaration. Thus, Applicants believe that no new declaration is required.

**Provisional Statutory Double Patenting**

Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application Nos. 09/833,118; 09/832,929;

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09/832,501; 09/833,111; and 09/833,117. Applicants wish to point out that claims 1-21 of the instant invention are being twice rejected over co-pending Application No. 09/833,118, and over the instant application itself, Application No. 09/833,111. Applicants also wish to bring to the Office's attention that responses to Office Actions in copending Application Nos. 09/833,118 and 09/833,041 have been filed separately on the same date as in the instant application.

Applicants traverse the provisional statutory double patenting rejection. The Office appears to be of the opinion that all of the copending applications claim the same subject matter, i.e. any therapeutic protein fused to human serum albumin (HSA). However, the claims are directed to fusion proteins in which HSA is fused to a "Therapeutic protein X," wherein such "Therapeutic protein X" is at least one or more of the therapeutic proteins listed in Table 1 (pages 11-251) of the specification. To clarify, Applicants have amended the independent claims 1 and 5-6 to state that "Therapeutic protein X is selected from at least one of the proteins set forth in Table 1." In each copending application, "Therapeutic protein X" is limited to the proteins listed in Table 1 in their respective applications. Each application discloses a different list of "Therapeutic protein X" in Table 1. Therefore, the applications do not claim the same invention and withdrawal of the rejection is respectfully requested.

### **Claim Rejections - 35 USC § 102**

Claims 1-3, 5-10, 13-14 and 17-21 are rejected under 35 U.S.C. 102 (b) as being anticipated by WO 97/24445 ("Delta"), or its Korean equivalent, KR99076789.

A finding of anticipation under 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described in a

single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). This standard precludes any finding of anticipation of the instant claims by Delta.

The Office alleges that Delta discloses serum albumin fusion proteins comprising the sequence set forth in SEQ ID NO: 18 of the instant application and therefore anticipates the claimed invention. In particular, the Office alleges that Delta discloses a fusion of albumin and a growth hormone. As discussed above, the Office has interpreted "Therapeutic protein X" as encompassing any "polypeptide, antibody, peptide, fragments or variants thereof." See Office Action, page 6. However, the claims now define "Therapeutic protein X" as those proteins listed in Table 1 of the specification. The growth hormone taught by Delta is not listed in Table 1 as one of the proteins that fall within "Therapeutic protein X." Thus, Delta does not anticipate the instant claims. Withdrawal of the rejection is respectfully requested.

Applicants note that claims 4, 11-12, and 15-16 were considered free of prior art because they were not rejected as being anticipated by Delta. These claims were rejected under provisional statutory double patenting, which is now rendered moot, as discussed above. Thus, Applicants believe that all claims are now in condition for allowance.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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